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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/718,770

11/22/2000

R. Terry Dunlay

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EXAMINER

SMITH, CAROLYN L

ART UNIT

PAPER NUMBER

1631

MAIL DATE

DELIVERY MODE

01/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/718,770

Applicant(s)

DUNLAY ET AL.

Examiner

Carolyn L. Smith

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 January 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 13-18 and 23-25.
Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

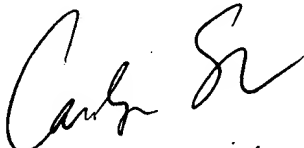
11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____

Continuation of 5. Applicant's reply has overcome the following rejection(s): The NEW MATTER rejections for claims 13-18 and 23-25.

Continuation of 11. does NOT place the application in condition for allowance because: the 35 USC 102 rejection is maintained. Applicants summarize MPEP section 2112, IV, and recite instant claim 13. Applicants argue that Nova et al. do not recite "collecting subcellular image data from the cells in the wells". This statement is found unpersuasive as Nova et al. disclose the following limitations:

Nova et al. disclose software reading one tag and encoded information including graphical displays, reports including progress (calculations) (col. 88, lines 16-34), searching for specific compounds with certain building blocks (feature data) including those already archived by displaying structure, archive location, microplate group name, number and well (col. 88, lines 55-62 and Figure 6), using fluorophors or other luminescent moieties, labeling molecules and biological particles, tagging molecules (abstract), tagging molecules such as antigens, antibodies, ligands, proteins, and nucleic acids and tagging by imprinting the matrix with identifying information (col. 4, lines 58-67 and col. 7, lines 6-15), using optical memories that rely on changes in chemical or physical properties of molecules and storing information associated with each matrix including reaction detection (col. 7, lines 16-32 and lines 57-67), a photodetector and recording devices to detect fluorescent occurrence or other optical emission (col. 10, lines 6-23), and using bar codes associated with each well in a microtiter plate (col. 8, lines 60-67) which represents collecting, calculating, storing, and retrieving subcellular image data, cell feature data, well summary data, plate summary data in a database, as stated in steps i) through ix) of instant claim 13 as well as instant claim 17. Nova et al. disclose optical memory devices (OMD) and image acquisition from a camera that can be displayed to the system monitor including edges and peak signals as well as determining the average intensity of each cell (col. 9, line 18; col. 51, line 61 to col. 52, line 9 and lines 27-60; and Figure 31) which represents collecting image data, intensity analysis, and feature data of cells, as stated in instant claims 13 and 23-25.

As discussed above, Nova et al. disclose fluorescently labeling molecules (i.e. proteins) and using photodetectors, recording devices to detect and store fluorescent emission data, and optical memories to store information regarding reaction detection with bar codes associated with each well in the microtiter plate as well as image acquisition which represents collecting subcellular image data from cells in the well. Applicants summarize the rejection and argue that the PTO has provided no basis for the definition of "sub-cellular image data". This statement is found unpersuasive as no clear and concise definition has been provided for "sub-cellular image data" in the specification which has resulted in this limitation to be interpreted broadly and reasonably. Applicants argue that Nova et al. do not teach collecting subcellular image data from within cells. This statement has already been addressed above and found unpersuasive. Applicants argue that "antigens, antibodies, ligands, proteins, and nucleic acids" are not located in a cell and are thus not subcellular. This statement is found unpersuasive and confusing as entities, such as proteins and nucleic acid, reside within cells and clearly represent sub-cellular entities. Applicants refer to col. 51-52 of Nova et al. and argue again that Nova et al. do not recite collecting subcellular image data from cells in wells. This statement has already been addressed above and was found unpersuasive. Applicants' arguments are deemed unpersuasive for the reasons given above.


AU 1631 examiner
4/25/07